

REMARKS

Claims 9-20 are now in this application. Claims 9-12 are rejected. Claims 9-12 are amended herein to clarify the invention, to broaden language as deemed appropriate and to address matters of form unrelated to substantive patentability issues. New claims 13-20 are added.

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims cited in the above-referenced Office Action.

Claims 9-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Onodera et al (US 5,570,993). Applicants herein respectfully traverse these rejections.

For a rejection to be sustained under § 102(b) each and every element of the claimed invention must be disclosed in the cited prior art reference. It is respectfully submitted that the cited reference fails to disclose at least the following features and elements of the present invention as noted herein.

The claims as presently written are directed to a method and device which each provide a feature, in accordance with which an amount of deviation between a feeding position of an electronic component and pick-up position of a suction nozzle overhead, as evidenced by data on an amount of displacement of the component from a prescribed holding position of the component suction nozzle based on posture

recognition results detected at a posture recognizing position, can be corrected for a subsequently-fed electronic component by adjustment to the component feeding position for that subsequently-fed component.

Applicants submit that the Onodera et al. reference is devoid of teaching relating to such feature, and therefore fails to anticipate the claimed inventions of claims 9-12. Although the Office Action broadly avers that Onodera et al. teaches the claimed subject matter of adjusting a feeding position, i.e. the position to which the component is transferred and picked up by the suction nozzle, based upon displacement amount data, no specific support allegedly present in the Onodera et al. disclosure has been identified by the Examiner. In accordance with Title 37, CFR, when a claim is rejected and "a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 CFR 1.106 (b). In order for the applicants to respond appropriately, it is respectfully requested that, in the event the pending claims are again rejected based on the cited reference, the Examiner set forth the relevant teachings in Onodera et al. with reference to relevant column and line numbers or reference designators.

Furthermore, it is respectfully submitted that a *prima facie* case of obviousness could not be established in rejection of amended claims 9-12. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First,

there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

It is respectfully submitted that the Onodera et al. reference cannot render the rejected claim obvious because the reference does not provide the teaching noted above with respect to the anticipation rejection. Thus, the reference fails to teach or suggest all the claim limitations, as properly required to establish a *prima facie* case of obviousness. Therefore, reconsideration of the rejection of claims 9-12 and their allowance are respectfully requested.

Claims 13-20 are added and are submitted as patentable over the cited art of record. The claims are submitted as patentable insofar as they recite features not believed disclosed in the cited art in the manner as claimed.

Applicants respectfully requests a one (1) month extension of time for responding to the Office Action. Please charge the fee of \$110 for the extension of time to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,
Jordan and Hamburg LLP

By C. Bruce Hamburg by:
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340

James D. Hill
Reg. No. 36,049